



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/334,617	06/17/1999	YOSHIHIRO IDA	P18051	5530

7055 7590 07/02/2004

GREENBLUM & BERNSTEIN, P.L.C.  
1950 ROLAND CLARKE PLACE  
RESTON, VA 20191

EXAMINER

GIBBS, HEATHER D

ART UNIT PAPER NUMBER

2622

18

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/334,617

Applicant(s)

IDA ET AL.

Examiner

Heather D Gibbs

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06/17/1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

DETAILED ACTION

*Response to Amendment*

1. The amendment filed on 05/14/2004 has been entered and made of record. Claims 1-23 are cancelled. Claims 24-30 are pending.

*Response to Arguments*

2. Applicant's arguments with respect to claims 23-30 have been considered but are moot in view of the new ground(s) of rejection.

*Claim Rejections - 35 USC § 102*

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 24-27,30 are rejected under 35 U.S.C. 102(e) as being anticipated by Saito et al (US 6,351,316).

For claim 23, which is representative of claims 27 and 30, Saito teaches of a server apparatus connected with a transmitting facsimile apparatus and a receiving facsimile apparatus via the Internet, the server apparatus comprising: a memory configured to store capabilities regarding facsimile data that the receiving facsimile apparatus can receive, the capabilities being distinct from the facsimile data (Col 3 Lines 64-67; Col 4 Lines 1-12); and a controller configured to receive facsimile data from the transmitting facsimile apparatus, to transform the received facsimile data into a type of facsimile data that the receiving facsimile apparatus can receive, based on the capabilities stored in the memory, and to

Art Unit: 2622

transmit the transformed facsimile data to the receiving facsimile apparatus (Col 2 Lines 50-59; Fig 4). (Col 3 Lines 64-67; Col 4 Lines 1-5

Regarding claim 25, Saito teaches wherein a capability regarding a facsimile data is a type of file data that the receiving facsimile apparatus can receive (Col 3 Lines 64-67; Col 4 Lines 1-12).

Considering claim 26, Saito teaches wherein a type of file data is at least one of MH, MR, MMR and JPEG (Col 3 Lines 64-67; Col 4 Lines 1-12).

4. Claim 29 is rejected under 35 U.S.C. 102(e) as being anticipated by Feder (US 5,872,845).

Feder teaches wherein an Internet facsimile apparatus connected with a server apparatus via the Internet, the Internet facsimile apparatus comprising: a communicator configured to communicate with a server apparatus via the Internet; and a controller configured to transmit to the server by email, capabilities regarding facsimile data that the Internet facsimile apparatus can receive, the transmitted email having a predetermined address, the email indicating the capabilities of the Internet facsimile apparatus to be stored in the server apparatus (Col 4 Lines 41-51; Col 5 Lines 47-55; Col 8 Lines 37-68; Fig 2A).

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2622

6. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al (US 6,351,316) in view of Feder (US 5,872,845).

Saito discloses the server apparatus as discussed above.

Saito does not disclose expressly wherein the controller determines whether or not the email address is the predetermined address, and in response to a determination that the email address is the predetermined address, stores the capabilities of the facsimile apparatus in the memory.

Feder discloses wherein the controller determines whether or not the email address is the predetermined address, and in response to a determination that the email address is the predetermined address, stores the capabilities of the facsimile apparatus in the memory (Col 8 Lines 46-50).

Saito & Feder are combinable because they are from the same scope of nature.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Saito and Feder.

The suggestion/motivation for doing so would have been as both systems deal with the transmission of facsimile data over the Internet and hence share cumulative features.

Therefore, it would have been obvious to combine Saito with Feder to obtain the invention as specified in claim 28.

### *Conclusion*

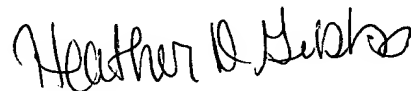
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather D Gibbs whose telephone number is 703-306-4152. The examiner can normally be reached on M-F 8AM-4PM.

Art Unit: 2622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

hdg



Heather D Gibbs  
Examiner  
Art Unit 2622



EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600